

REMARKS

Applicant respectfully requests reconsideration of the present application in view of this response. Claim 52 has been added and claims 1-52 are currently pending.

PRIOR ART REJECTIONS

Claim Rejections under 35 U.S.C. § 102(e)

Claims 16, 18, 30, 33, 44, and 46 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Pardo (U.S. Patent No. 6,266,539). Applicant respectfully traverses this rejection.

On page 5 of the Office Action the Examiner relies upon the Abstract, FIGs. 7, 8, 12 and col. 9, ll. 2-20 of Pardo for allegedly teaching, “a memory for storing a list of phone features and phone policies therein,” as set forth in claim 16, and further relies upon the Abstract, FIGs. 7, 8, 12, col. 7, ll. 60-67 and col. 9, ll. 2-20 of Pardo for allegedly teaching, “software stored in the memory for allowing a user to select any program in the user’s personal phone features and phone policies within the PDA from the stored list of phone features and phone policies, at least one of the user’s personal phone policies being used to implement at least one of the user’s personal phone features in a telecommunication system,” as also set forth in claim 16. However, Applicant respectfully disagrees with the Examiner’s conclusion.

FIG. 7 of Pardo is a display screen illustrating a speed dialing function and FIG. 8 is a display screen illustrating various telephony functions of Pardo. Further, col. 9, ll. 2-20 of Pardo states:

The user may periodically connect the PDA to the PC to upload/download personal data, such as new telephone numbers, and possibly to print old data and perform data maintenance. The user may also want to use the PDA to ease the use of his telephone, access Web sites and email via his

telephone, perhaps use Web access for such applications as on-line yellow pages, or have the convenience of access to Web access while away from the PC in the office. It is possible that the docking telephone is used in a hot and humid kitchen. Because the docking telephone does not especially require a PC, it may be used in many rugged non-office environments where a telephone or a telephone and a PDA are used today. For example – a person uses the integrated smart phone to read email and selected Web sites before going to sleep; during the night the smart phone automatically polls the email; the person reads the email on the way to work. The docking telephone may be used in a domestic setting, including a kitchen, or in an office in any type of industrial environment.

However, Applicant respectfully submits that the above-cited portion of Pardo in no way teaches or suggests, "at least one of the user's personal phone policies being used to implement at least one of the user's personal phone features in a telecommunication system," as set forth in claim 16. Instead, Pardo merely discloses a telephone docking station that allows a personal digital assistant (PDA) to be connected to it. Pardo's telephone docking station includes telephone circuitry, which performs basic telephone functions and a modem. Pardo discloses that the connected PDA can be used to perform automatic dialing of stored phone numbers, browse the Worldwide Web, or perform three-way calling, call forwarding, or caller-id blocking. That is, the PDA, as disclosed by Pardo, provides all communication functionality, other than the basic telephony services and modem functionality, which are provided by the telephone docking station. Thus, any phone features disclosed in Pardo are not implemented in the telecommunication system (telephone network), but instead, remain within, and are performed by, the PDA. Therefore, Applicant respectfully asserts that Pardo fails to teach or suggest at least, "allowing a user to select and program the user's personal phone features and phone policies within the PDA from the stored list of phone features and phone policies, at least one of the user's personal phone policies being used to implement at least one of the user's personal

phone features in a telecommunication system", as set forth in claim 16. Accordingly, Applicant respectfully submits that claim 16 is in condition for allowance.

With regard to claims 18, 30, 33, 44 and 46, Applicant respectfully submits that these claims are also allowable for at least reasons somewhat similar to those set forth above with regard to claim 16; however, these claims should be interpreted solely by the limitations present therein.

Claim Rejections under 35 U.S.C. § 102(e)

Claims 16-18, 30-33, and 44-46 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Kikinis et al. (U.S. Patent No. 5,799,068, hereinafter referred to as Kikinis). Applicant respectfully traverses this rejection.

On pages 5 and 6 of the Office Action, the Examiner relies upon the "serial number" and "perhaps other codes," of Kikinis for allegedly teaching, "phone features and phone policies," as set forth in claim 16, and further relies upon the, "control routines and data files...stored in [Memory 1013]," (see pages 5 and 6 of the Office Action) for allegedly teaching, "software stored in the memory for allowing the user to select and program the user's personal phone features and phone policies within the PDA from the stored list of phone features and phone policies, at least one of the user's personal phone policies being used to implement at least one of the user's personal phone features in a telecommunication system," as set forth in claim 16. However, Applicant respectfully disagrees with the Examiner's conclusion.

As the Examiner is aware, under current United States Patent and Trademark Office Practice, each claim must be interpreted as a whole. However, in the rejection set forth on pages 5 and 6 of the Office Action, it appears that the Examiner has relied upon the "serial number," and "perhaps other codes," of Kikinis for teaching the, "phone features," and "phone policies,"

stored in a memory and then later relied upon, "control routines for applications and data files," of Kikinis for also allegedly teaching, "at least one of the user's personal phone policies being used to implement at least one of the user's personal phone features in a telecommunication system," as set forth in claim 16. That is, the Examiner has relied upon four different elements of Kikinis (i.e., the "serial number," and "perhaps other codes," and "control routines for applications and data files," of Kikinis) for allegedly teaching two limitations (i.e., "phone features," and "phone policies,") as set forth in claim 16. Accordingly, Applicant respectfully submits that Kikinis fails to teach or suggest at least, "phone features," and "phone policies," which are stored in a memory and at least one of the, "phone features," being used to implement at least one of the "phone policies," as set forth in claim 16. Accordingly, Applicant respectfully submits that claim 16 is in condition for allowance.

With regard to claims 17, 18, 30-33 and 44-46, Applicant respectfully submits that these claims are also allowable for at least reasons somewhat similar to those set forth above with regard to claim 16; however, these claims should be interpreted solely by the limitations present therein.

Claim Rejections under 35 U.S.C. § 102(e)

Claims 16, 18, 30, 33, 44 and 46 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Graham (U.S. Provisional Patent No. 60/098,187, hereinafter referred to as Graham). Applicant respectfully traverses this rejection.

On page 8 of the Office Action, the Examiner relies upon Figure 6, page 5, paragraph 1, page 1, paragraphs 1 and 5 of Graham for allegedly teaching limitations set forth in claim 16. However, Applicant respectfully disagrees with the Examiner's conclusion.

Page 1, paragraphs 1 and 5 (of Graham) disclose a Hermes Call Slip Architecture, which provides a user interface presenting different options based upon the current state of a telephone (i.e., ringing, receiving caller I.D.). The Hermes Architecture also provides a standardized graphical interface for operating line management and call control features, and for developing and delivering new line or call control features.

However, Applicant respectfully submits that Graham fails to teach or suggest, "at least one of the user's personal phone policies being used to implement at least one of the user's personal phone features in a telecommunication system," as set forth in claim 16. Instead, the above noted portions of Graham merely disclose an interface allowing a user to interact with a phone device. That is, the interface of Graham allows a user to make selections and operate the phone device and not using, "at least one of the user's personal phone policies...to implement at least one of the user's personal phone features in a telecommunication system," as set forth in claim 16.

On page 8 of the Office Action, the Examiner further relies upon page 5, paragraph 1, which states:

Certain aspects of this user interface and architecture can be added to any Windows device wishing to become more telephone enhanced – from a user perspective. For example, a Palm-sized PC can be equipped with the Call Slip interface that interacts with a PBX phone and the PC to show call information and control features on a docked device – enhancing the capabilities of the phone while tying in to the network capabilities of the PC.

However, Applicant respectfully submits that the above-cited portion of Graham also fails to teach or suggest, "at least one of the user's personal phone policies being used to implement at least one of the user's personal phone features in a telecommunication system," as set forth in claim 16. Instead, similar to that as discussed above, the above recited portion of

Graham merely discloses a Palm-sized PC, which "interacts with a PBX phone and PC to show call information with control features on the docked device," (see above). That is, the Palm-sized PC merely acts as a bridge, which displays information arguably provided from both a PBX phone and a PC. The Palm-sized PC does not, however, implement at least one of the user's personal phone features in a telecommunication system using at least one of the user's personal phone policies, as set forth in claim 16. Accordingly, Applicant respectfully submits that claim 16 is in condition for allowance.

Further, with regard to claims 18, 30, 33, 44 and 46, Applicant respectfully submits that these claims are also allowable for at least reasons somewhat similar to those set forth above with regard to claim 16; however, these claims should be interpreted solely by the limitations present therein.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-3, 5-11, 19-24, 34-38, 47 and 48 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Graham in view of Mattaway (U.S. Patent No. 6,009,469, hereinafter referred to as Mattaway). Applicant respectfully traverses this rejection.

Initially, similar to that as discussed above with regard to claim 16, for example, Applicant respectfully submits that Graham does not teach or suggest, "at least one of the user's personal phone policies being used to implement at least one of the user's personal phone features in a telecommunication system," as set forth in claim 1.

Furthermore, on page 11 of the outstanding Office Action, the Examiner correctly recognizes that Graham fails to teach or suggest, "downloading at least a portion of the arranged information to an internet protocol phone device," as set forth in claim 1, and relies upon

Mattaway for allegedly teaching this limitation. However, Applicant respectfully disagrees with the Examiner's conclusion.

Mattaway is directed to a communication utility for establishing point-to-point communications between processes over a computer network. Specifically, with regard to FIG. 15A, Mattaway discloses a global server 1500 and various devices (e.g. ISP 1528, CSU/DSU 1526) operatively coupling the global server to the internet 1530. A Webphone 1536, is coupled to the internet 1530 through an Internet service provider (hereinafter ISP) 1532. Global server 1500 further includes a database 1516 which interacts with control server 1512 and information server 1514 through database server 1518. Database 1516 includes a Client table 1516A, an On-line table 1516B, a WebBoard table 1516C a Web Board configuration table 1516D and a WebBoard source table 1516E.

Further, Client Table 1516A includes a separate record corresponding to each Webphone user (i.e. client), and each record includes information defining the client's profile of personal information (see col. 20 lines 27-35).

However, Applicant respectfully submits that Mattaway fails to teach or suggest, "downloading at least a portion of the arranged information to an internet protocol phone device," as set forth in claim 1.

The client table 1516A, as disclosed by Mattaway, is located in a database 1516, which is further included in a global server 1500 (see Mattaway col. 20, lines 16-17 and FIG. 15A). Each Webphone user (i.e. Client), has a separate record in the Table 1516A, including information defining an individual "clients profile of personal information" (see Mattaway, col. 20, lines 31-32). However, Mattaway makes no mention or suggestion of "downloading at least a portion of the arranged information to an Internet Protocol (IP) phone device," as set forth in claim 1. In

contrast, Mattaway discloses the storage of information in a database within a global server 1500 (see FIG. 15A), not within an "Internet Protocol (IP) phone device," and, therefore, does not disclose the "downloading at least a portion of the arranged information to an Internet Protocol (IP) phone device," as set forth in claim 1.

Thus, even assuming *arguendo* that Mattaway could be combined with Graham (which Applicant does not admit); Applicant respectfully submits that Mattaway still fails to teach or suggest, "downloading at least a portion of the arranged information to an Internet Protocol (IP) phone device," as set forth in claim 1. Accordingly, Applicant respectfully submits that neither Graham nor Mattaway, either alone or in combination, teach or suggest all of the limitations set forth in claim 1. As such, Applicant respectfully submits that claim 1 is in condition for allowance.

With regard to claims 2-3, 5-11, 19-24, 34-38, 47 and 48, Applicant respectfully submits that these claims are also allowable for at least reasons somewhat similar to those discussed above with regard to claim 1; however, these claims should be interpreted solely by the limitations present therein.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 4, 12, 25, 26, 39 and 40 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Graham in view of Mattaway and Kikinis. Applicant respectfully traverses this rejection.

With regard to claim 4, on page 17 of the Office Action, the Examiner relies upon Graham for allegedly teaching, "transferring the IP phone device according to the arranged information." However, Applicant notes that a "transferring" step is recited in claim 12 and not in claim 4. Accordingly, in view of the Examiner's omission of the "operating the IP phone

device according to the arranged information," as set forth in claim 4, Applicant assumes that the Examiner is of the opinion that Graham fails to teach or suggest this limitation.

On page 16 of the Office Action, the Examiner correctly recognizes that Graham fails to teach or suggest an IP phone device as set forth in claim 4 and relies upon Mattaway for allegedly teaching this limitation. Further, on page 18 of the Office Action, the Examiner correctly recognizes that Graham fails to teach or suggest at least, "prestorage identity information of the user in the PDA," and "verifying, in the PDA, the identity of a current user based on the prestored identity information," as set forth in claim 4.

However, Applicant respectfully submits that even assuming *arguendo* that Mattaway and/or Kikinis could be combined with Graham (which Applicant does not admit), Applicant respectfully submits that neither Mattaway nor Kikinis teaches or suggests the "operating," step of claim 4 and, thus, would still fail to at least make up for the deficiencies of Graham as discussed above. Accordingly, Applicant respectfully submits that neither Graham, Mattaway, nor Kikinis, either alone or in combination, teach or suggest all of the limitations set forth in claim 4.

With regard to claim 12, on page 17 of the Office Action, the Examiner relies upon Graham for allegedly teaching, "transferring the IP phone device according to the arranged information." However, similar to that as discussed above with regard to claim 4, this "transferring the IP phone device according to the arranged information," limitation is not recited in claim 12; instead, claim 12 recites, "transferring the arranged information to an Internet Protocol-Public Branch Exchange." However, Applicant respectfully submits that Graham fails to teach or suggest at least, "transferring the arranged information to an Internet Protocol-Public Branch Exchange."

As discussed above with regard to claim 16, page 1, paragraphs 1 and 5 (of Graham) disclose a Hermes Call Slip Architecture, which provides a user interface presenting different options based upon the current state of a telephone (i.e., ringing, receiving caller I.D.). The Hermes Architecture also provides a standardized graphical interface for operating line management and call control features, and for developing and delivering new line or call control features. Furthermore, page 5, paragraph 1 of Graham states:

Certain aspects of this user interface and architecture can be added to any Windows device wishing to become more telephone enhanced – from a user perspective. For example, a Palm-sized PC can be equipped with the Call Slip interface that interacts with a PBX phone and the PC to show call information and control features on a docked device – enhancing the capabilities of the phone while tying in to the network capabilities of the PC.

However, Applicant respectfully submits that none of the above-cited portions of Graham also teach or suggest, "transferring the arranged information to an Internet Protocol-Public Branch Exchange," as set forth in claim 12. Instead, the above recited portion of Graham merely discloses a Palm-sized PC, which interacts with a PBX phone and PC to "show call information with control features on the docked device." That is, the Palm-sized PC merely acts as a bridge, which displays information arguably provided from both a PBX phone and a PC. The Palm-sized PC does not, however, transfer "the arranged information to an Internet Protocol-Public Branch Exchange," as set forth in claim 12.

On page 16 of the Office Action, the Examiner correctly recognizes that Graham fails to teach or suggest, an "Internet Protocol-Public Branch Exchange (IP-PBX)," as set forth in claim 12, and relies upon Mattaway for allegedly teaching this limitation. Further, on page 18 of the Office Action, the Examiner correctly recognizes that Graham fails to teach or suggest, "prestorage identification data of the user in the PDA," and "verifying, before said arranging

step, the identity of a current user of the PDA based on the prestored identification data," as set forth in claim 12, and relies upon Kikinis for allegedly teaching this limitation.

However, Applicant respectfully submits that even assuming *arguendo* that Mattaway and/or Kikinis could be combined with Graham (which Applicant does not admit), Applicant respectfully submits that Mattaway and Kikinis still fail to teach or suggest at least, "transferring the arranged information to an Internet Protocol-Public Branch Exchange," as set forth in claim 12 and, therefore, would still fail to at least make up for the deficiencies of Graham as discussed above with regard to claim 12. Accordingly, Applicant respectfully submits that neither Graham, Mattaway nor Kikinis, either alone or in combination, teach or suggest all of the limitations set forth in claim 12.

With regard to claim 25 and dependent claim 26, as discussed above with regard to claim 16, for example, Applicant respectfully submits that Graham does not teach or suggest, "at least one of the user's personal phone policies being used to implement at least one of the user's personal phone features in a telecommunication system," as set forth in claim 25.

Furthermore, on page 16 of the Office Action, the Examiner correctly recognizes that Graham fails to teach or suggest, a memory, which stores "prestored identification data for the user," as set forth in claim 25, and relies upon Kikinis for allegedly teaching this limitation. However, Applicant respectfully submits that even assuming *arguendo* that Kikinis could be combined with Graham (which Applicant does not admit), Applicant respectfully submits that Kikinis still fails to teach or suggest, "at least one of the user's personal phone policies being used to implement at least one of the user's personal phone features in a telecommunication system," as set forth in claim 25 and, therefore, would still fail to at least make up for the deficiencies of Graham as discussed above with regard to claim 25. Accordingly, Applicant

respectfully submits that neither Graham nor Kikinis, either alone or in combination, teach or suggest all of the limitations set forth in claim 25 and dependent claim 26.

With regard to claim 39 and dependent claim 40 and further with regard to claims 25 and 26, one page 19 of the Office Action, the Examiner applies the rejection of claims 4 and 12 to claims 25, 26, 39, and 40; however, Applicant respectfully submits that the above rejection of claims 4 and 12 does not address several limitations as set forth in claims 25 and 39. For example, neither claim 4 nor claim 12 recites, "at least one of the user's personal phone policies being used to implement at least one of the user's personal phone features in a telecommunication system," as set forth in claim 25, or "connection means for connecting the PDA and the IP-PBX," as set forth in claim 39. Accordingly, as the Examiner has not identified any portions of Graham, Mattaway or Kikinis, which allegedly teach these limitations set forth in claims 25 and 39, respectively, Applicant assumes that the Examiner is of the opinion that none of the above cited references teach or suggest these limitations set forth in claims 25 and 39.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 13-15, 27-29, 41-43, and 49-51 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kikinis in view of Graham. Applicant respectfully traverses this rejection.

On page 20 of the Office Action the Examiner correctly recognizes that Kikinis fails to teach or suggest, "phone features of a plurality of users...[and] phone policies of the plurality of users," as set forth in claim 13, for example, and relies upon Graham for allegedly teaching these limitations. In support of the combination of Kikinis and Graham, the Examiner provides the following alleged motivation:

It would have been obvious to one of ordinary skill in the art at the time the invention to implement the multiuser capability of Graham in the invention of

Kikinis; because the downloading of executable program files yielding 'several different program lists' on the microPDA of Kikinis would enable the invention of Kikinis to be used by multiple individuals or an administrator. (see page 21 of the Office Action)

However, Applicant respectfully submits that the above statement by the Examiner does not provide any suggestion or motivation as to why the skilled artisan would combine the teachings of Kikinis and Graham. Instead, the Examiner has merely stated that the combination of Kikinis and Graham would allegedly "enable the invention of Kikinis to be used by multiple individuals or an administrator." However, Applicant respectfully submits that the mere fact that the alleged combination of Kikinis and Graham may arguably allow the invention of Kikinis to be used by multiple users or an administrator is not sufficient to establish a *prima facie* case of obviousness as to why the skilled artisan would be motivated to combine the teachings of Kikinis with the teachings of Graham. In combining multiple references under 35 U.S.C. §103(a), the Examiner must supply evidence of necessary motivation, which would lead one of ordinary skill in the art to combine the teachings of Kikinis and Graham as forth in two cases decided by the Court of Appeals for the Federal Circuit (CAFC), *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir. 1999) and *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000). However, Applicant respectfully submits that the Examiner has failed to do so and, thus, should withdraw the outstanding rejection under 35 U.S.C. § 103(a) in view of Kikinis and Graham.

Furthermore, with regard to claims 14-15, 27-29, 41-43 and 49-51, Applicant respectfully submits that these claims are also allowable for at least reasons somewhat similar to those set forth above with regard to claim 13; however, these claims should be interpreted solely by the limitations presented therein.

NEW CLAIM

Applicant has added new claim 52 by way of this response, which includes limitations somewhat similar to those set forth in claim 1. As such, Applicant respectfully submits that claim 52 is also allowable for at least reasons somewhat similar to those set forth above with regard to claim 1; however, claim 52 should be interpreted solely by the limitations presented therein.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 1-51 in connection with the present application is earnestly solicited.

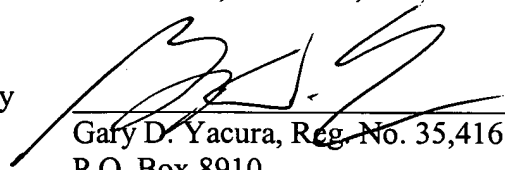
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary Yacura at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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